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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/187,749 11/09/98 UTSUMI

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JAMES D HALSEY JR
STAAS & HALSEY
700 ELEVENTH STREET NW
SUITE 500
WASHINGTON DC 20001

TM02/0703

EXAMINER

IRSHADULLAH.M

ART UNIT

PAPER NUMBER

2163

DATE MAILED:

07/03/01 12

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/187,749

Applicant(s)
Utsumi et al.

Examiner
M. Irshadullah

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2163



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Apr 9, 2001
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

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DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 28, 2001 has been entered.

2. This communication is in response to the amendments filed February 28, 2001 and April 08, 2001.

Summary Of Instant Office Action +

3. Applicant's arguments, filed February 28, 2001, concerning claims 1-8 rejections, para 7, Office Action, Paper No. 7, mailed November 30, 2000 and Advisory Action, Paper No. 9, mailed March 16, 2001 have been considered, deemed unpersuasive and are maintained.

4. Applicant's amendments to claims 2, 3, 5 and 6 have been entered.

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5. Objections under para 5 (not 8-Applicant's response, page 5) of the Office Action, Paper No. 7, is withdrawn.

6. Office Action, Paper No. 7, mailed November 30, 2000, Page 6, Claim 5: Please amend Fig. 7 to Fig. 5.

Advisory Action, Paper No. 9, page 2, para 3, please amend " col 5, lines 3-5 " to read as " col 5, lines 3-65 ".

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-8 are rejected under 35 U.S.C. 103(b) as being unpatentable over Ross et al (US Patent 5,553,139) in view of Hasebe et al (US Patent 5,392,351).

Ross et al disclose:

Claim 1. A license devolution apparatus [Title and col 1, lines 7-8] accessing a first storage medium storing contents encrypted with a predetermined key [Col 1, line 57, recited

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with lines 52-53, Fig. 6B described col 1, lines 46-51, Fig. 5 (Enabler Keys), Fig. 2 (210, 216, 218) recited with col 6, lines 1-3, 8-13, 16 and 19-20. It needs be mentioned that the use of a predetermined (enabler) key or a key generated during encryption process are notoriously known in the art under discussion], a first media ID identifying the first storage medium [Please see discussion below], and a first encryption secure information generated by encrypting the key and a first use information, representing a right to use the contents, together with one another or individually, with the first media ID, and accessing a second storage medium, storing a second media ID identifying the second storage medium [Please see discussion below], wherein the right of using the contents stored in said first storage medium is devolved from said first storage medium to said second storage medium [Col 6, line 49, col 1, lines 51-54 read with lines 37-38 (application/content of first media/CD and by the same token another application program/content relating to second media/diskette), and col 6, lines 40-49 together with lines 52-54], yet

Ross et al do not show:

a first media ID, identifying the first storage medium,

(storing) a second media ID identifying the second storage media.

However, Hasebe et al teach the same [Fig. 2 (12) described col 2, lines 9-12, col 9, lines 1-9].

It would have been obvious to one of ordinary skill in the license/information protection/securing art at the time of applicant's invention to include media IDs in Ross et al's invention, because it would provide additional/enhanced protection to electronic data/information in addition to copyright protection.

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said license devolution apparatus comprising:

a) decoding means for decoding the first encryption secure information stored in said first storage medium using the first media ID to obtain the key and the first use information [Ross et al: Col 4, lines 22-24, col 6, lines 40-59 (specifically line 49, 52-56), col 7, lines 28-40, 47-55, Fig 4 described col 7, lines 56-65 continue col 8, lines 5-8, and Fig. 7 (C, D, E), and discussion about media ID above]; and

b) encryption means for encrypting with the second media ID, the key and a second use information, representing a second right to use the contents that is devolved from the first storage medium to the second storage medium together with one another or individually with the second media ID, to generate a second encryption secure information for storage in said second storage medium [Ross et al: Fig 2 (210, 218), Fig. 5 (A, B), col 3, lines 17-24, col 6, lines 40-49 and 51-52 recited with col 4, lines 8-15, col 3, lines 34-45 and col 7, lines 32-55, and discussion about media ID above].

Claim 2. A license devolution apparatus according to claim 1, wherein said encryption means encrypts with the first media ID a third use information, obtained through subtracting the second use information from a first use information, or encrypts with the first media ID both the key and the third right of using, to generate a third secure information and stores the third encryption secure information in the first storage medium [Ross et al: Fig. 2 (210, 218), Fig 5 (A, B), Fig. 5 (any of 2-4 would be considered as third user of the third right

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of using and obtained by eliminating/subtracting the second right of using from the first right of using) and col 3, lines 40-45, and discussion about media ID above].

Claim 3. A license devolution apparatus according to claim 1, wherein if the entire rights of using the contents, to which the first storage medium is entitled, are devolved to the second storage medium [Claim 1, lines 37-41, col 4, lines 8-15 and col 6-col 7(upto line 20)], the first encryption secure information stored in the first storage medium is destroyed [Ross et al: Fig. 1 (102), col 4, lines 16-18. Applicant will appreciate that reference's disabling function/process would be used to disable/erase/delete/destroy the secure information stored in the first storage medium after transferring the information to another/second etc. media].

Claim 4. A license devolution apparatus according to claim 1, wherein before devolution of the right to use the contents, the first storage medium stores contents whose right to use is intended to be devolved as encrypted contents [Figs. 6A and 6B described col 1, lines 31-61], and

wherein said license devolution apparatus further comprises contents transfer means for reading the encrypted contents from the first storage medium, and storing in the second storage medium the read encrypted contents [Claim 1, lines 37-41. Reading devices, like diskette or CD drives are inherently implied].

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Claim 5. A license devolution apparatus according to claim 2, wherein the first use information and the second use information represent the presence of the right to use, and the third use information represents the absence of the right to use [Fig. 5, any of 2-4 would be a first (user) of first use information, a second (user) of second use of information and when two are using the use information, third one (say, installer) would be unable/absent to have the right of using the use information unless the use information is transferred/distributed/devolved simultaneously to all].

Claim 6. A license devolution apparatus according to claim 2, wherein the first use information represents of a first available number of times or available time, the second use information is represents a second available number of times or available time which is less than the first available number of times or available time, and the third use information represents a third available number of times or available time which is obtained through subtracting the second available number of times or available time from the first available number of times or available time [Inherently implied, since the user under the agreement would be obliged to use the product (document, picture or program) for certain number of time(s) and when one user would transfer/devolve the right of use, he could only do so for the remainder of one's available number of times].

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Claim 7. A license devolution apparatus according to claim 1, further comprising a first drive and a second drive driving the first storage medium and the second storage medium, respectively, said first drive and said second drive having a first firmware and a second firmware accessing the first storage medium and the second storage medium, respectively [Inherently implied; the diskette or CD or other media drives have their respective drivers or softwares/firmwares for running the same],

wherein said decoding means and said encryption means are arranged in a firmware consisting of said first firmware and said second firmware in form of a composite unit; and wherein only said first firmware has authority to access the first storage medium driven by said first drive, and only said second firmware has authority to access the second storage medium driven by said second drive [Inherently implied; each driver (software/firmware) would be able (have authority) to run its respective media having an ID and access the information on it].

In the following claim Ross et al show: “ a predetermined key [Fig. 5 (Enabler Key) ”, and do not explicitly show “ storing in storage media ”.

Claim 8. A license devolution method, comprising:

However, Hasebe et al teach the following except above mentioned “ predetermined key ”:

a) storing in a first storage medium contents encrypted with a predetermined key, a first media ID identifying the first storage medium, and encryption secure information generated by encrypting with the first media ID, the key and a first use information, which represents a right to

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use the contents [Fig. 4 (s3, s6, s7) described col 6, lines 3-43, Fig. 2 (12, 13, 14), col 4, lines 10-15. Col 5, lines 3-7].

“Storing” in computer art is notoriously known. It would have been obvious to one of ordinary skill in the art at time of instant invention to use the available technique/procedure.

Following steps are method steps of apparatus claim above, same rationale applies as to elements claim 1(a) and 1 (b) above.

b) decoding the first encryption secure information using the first media ID to obtain the key and first use information;

c) generating a second encryption secure information by encrypting with a second media ID, which identifies a second storage medium, the key and second use information, which represents a second right to use the contents that is devolved from the first storage medium to the second storage medium; and

storing the second encryption secure information in said second storage medium, wherein the right to use the contents stored in the first storage medium is devolved from the first storage medium to the second storage medium [Hasebe et al: Fig. 4 (s3, s6, s7), col 6, lines 3-43 read with col 4, lines 62-64, col 9, lines 6-9].

Response to Arguments

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9. Applicant's arguments filed February 28, 2001 and April 09, 2001 have been fully considered, but the same are not persuasive.

Applicants are advised to take Ross et al and Hasebe et al references into consideration in combination with each other, instead of severally.

Applicant (February 28) argues:

a) Page 6: " a second use information accommodating Regarding Examiner's comments third use information, describe devolution of the use right (claims 1, 2, 5 and 6). Initial use information. Claims 5 and 6..... thereby now depending from claim 2 ".

Applicant will appreciate that Examiner understood and meant as the new/second/third changed/devolved/transferred "use right/changed use information ".

b) Page 6: " use information which indicatethe range of the right of using (specification, page 5, lines 8-18 and page 8, line 22 to page 9, line 1). Hasebe does not disclose "use information ". Ross does not disclose or suggest " use information. The Examiner..... " use information " corresponds to Ross's "license"..... . Ross uses the term "license", but is silent on the details of it ". Applicant is referred to Fig. 5, described col 3, lines 14 through col 4, lines 1-15, 64-67. Serial number, nonetheless would considered medium ID, yet Hasebe et al clearly recite the same, Fig. 2 (12), col 4, lines 9-11. Regarding specification's page 5, lines 8-18, Applicant is referred to instant claims 2 and 5 rejections. In respect of page 8, line 22 through page 9, line 1, Applicant is directed to Ross et al: Col 3, line 31, col 4, line 53 { extractor's (e.g.,

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reseller's) password }, col 5, lines 29, 40-43, col 6, line 20, line 61, col 7, lines 1-2 etc.

Applicant will appreciate that Ross et al's encrypting the password//identifying a person would be used for any user, primary (manufacturer), intermediary (reseller's etc.) or end user, and when the use right/information on a medium would be transferred/devolved from one to next/other, first one will be absent and the next/other one will be present.

c) Page 6: " Ross's license is enabling information voice operator ". Applicant is directed to Ross et al, Abstract, lines 8-10, col 2, lines 23-27, col 5, lines 46-47, col 6, lines 43-45, 52-53 and col 7, lines 54-55. Applicant will appreciably realize that lincense(s) is/are being distributed through storage media, enabler key is obtained electronically or by voice operator.

d) Page 6: " Fig. 7..... , continue page 7,
..... (Ross col 8, lines 9-21). Applicant will appreciate that Ross et al's process controls only unauthorized use, otherwise authorized users can transfer/devolve or use the use information stored on the storage medium as they wish and as many times they want.

e) Page 7: " See for example
..... using media ID ". As stated above, the license content/information is stored on a storage medium and distributed to various users(Ross et al, col 7, lines 54-55 recited with col 8, lines 12-13) for authorized use without any restriction on use or number of times it would be used or transferred/devolved.

Applicant (April 09, 2001) argues:

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A) Hasebe relates to preventing copying of information stored on a medium. Applicant is referred to Hasebe et al, Abstract, lines 1-2, which clearly prevents illegal copying; on the other hand, allow/permit legal copying/transfer/devolution/use without any restriction. As discussed above, Ross et al do the same; i.e., prevent only unauthorized/illegal use or distribution, transfer/devolution and put no restriction, what so ever (use or giving the right to use any number of times the user/manufacturer/installer/extractor agent wishes).

In the light of above stated facts , Examiner respectfully states that applicant's arguments have been fully considered, deemed unpersuasive and the rejections under prior Office Action, Paper No. 4, mailed April 26, 2000 are maintained.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


A) Erickson, US Patent 5765,152. System And Method For Managing Copyrighted Electronic Media.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Irshadullah whose telephone number is (703) 308-6683. The examiner can normally be reached on M-F from 11:00 am to 5:30 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz, can be reached on (703) 305-9643. The fax numbers for the organization are (703) 305-0040/308-6306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-3900.


M. Irshadullah

June 27, 2001


TARIQ R. HAFIZ
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100